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MAILED

NOV 08 2011

OFFICE OF PETITIONS

In re Patent of :
Paul et al. :
Patent No.: 6,112,136 :
Issue Date: 08/29/2000 :
Application No. 09/079298 :
Filing or 371(c) Date: 05/12/1998 :
Title of Invention:
SOFTWARE MANAGEMENT OF AN :
INTELLIGENT POWER :
CONDITIONER WITH BACKUP SYSTEM :
OPTION EMPLOYING TREND ANALYSIS :
FOR EARLY PREDICTION OF AC POWER :
LINE FAILURE :

This is a decision on the petition under 37 CFR § 1.378(b), filed October 12, 2011, to reinstate the above-identified patent.

The petitions are DISMISSED.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision. The petition for reconsideration should be entitled "Petition for Reconsideration under 37 CFR 1.378(e)." Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of \$400 as set forth in 37 CFR 1.17(h).

Background

The patent issued August 29, 2000. Petitioner/Patentee could have paid the seven and one half (7½) year maintenance fee between August 29, 2007, and February 29, 2008, without a surcharge, or within the six (6) month grace period between March 1, 2008 and August 29, 2008. Petitioner/Patentee failed to do so; accordingly, the patent became expired on August 30, 2008.

The present petition

Petitioner files the present petition and provides that petitioner is the assignee of the present patent by virtue of an assignment on May 12, 1998, recorded in this Office at Reel 009184, Frame 0533. Prior to the assignment, petitioner obtained an interest in the patent through a Security Agreement conveyed to petitioner on September 27, 1991.

Petitioner and current assignee of the patent, by and through its President, Gary Jungwirth, timely paid the first 3½ year maintenance fee which was accepted by this Office without question. Thereafter, on July 28, 2004, petitioner sent a notice to this Office to change the correspondence address to that of Gary Jungwirth.

Petitioner thereafter received a Notice of Patent Expiration on September 29, 2008, and on October 20, 2008, petitioner filed a petition to accept an unintentionally delayed payment of the maintenance fee. The petition was dismissed in a decision mailed November 17, 2008, because petitioner had not established that he was authorized to act on behalf of the assignee.

On February 4, 2009, petitioner filed a facsimile message to this Office to the effect that he had telephoned this Office several times and had not received a call back from anyone. Petitioner subsequently sent a letter via facsimile to this Office attempting to resolve the matter. On April 27, 2009, petitioner filed a statement under 37 CFR 3.73(b), along with a check for \$400.00.

Petitioner in response received a letter from this Office on July 15, 2009, informing petitioner that the statement under 37 CFR 3.73(b) failed to list the Reel and Frame number for the assignment recorded for this patent.

Petitioner thereafter, on July 21, 2009, averred that he had completed the form (Statement Under 37 CFR 3.73(b)), along with payment of \$400.00.

This Office again mailed a Requirement for Information on March 16, 2010, informing petitioner that he still had not demonstrated that he was authorized to act on behalf of the assignee.

The 24-month period for filing a petition to reinstate the patent based upon unintentional delay having expired, petitioner files the present petition.

Petitioner initially takes issue with the fact that the Office challenged petitioner's right to timely pay the first maintenance fee, but thereafter the Office denied (dismissed) petitioner's petition to accept an unintentionally delayed payment of the second maintenance fee. Petitioner cites to 37 CFR 1.366, which states in relevant part that any person or organization may pay the maintenance fee. Petitioner asserts that it was reasonable for petitioner to assume that the unintentionally delayed payment of the maintenance fee would be accepted since the first maintenance fee, timely paid, was accepted.

Petitioner argues that the Security Agreement did not transfer ownership of the patent, and despite the Security Agreement petitioner should have been allowed to pay the maintenance fee

because petitioner was the rightful owner of the patent at the time payment of the seven and one half (7½) year maintenance fee was attempted.

Applicable Law, Rules and MPEP

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. See Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

Because 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee

and the failure to receive the Maintenance Fee Reminder does not constitute unavoidable delay. See Patent No. 4,409,763, supra. See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullah, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Opinion

Initially it is noted that petitioner is correct that anyone may pay the maintenance fee. However, once the patent is expired, one of the requirements of a grantable petition to accept an unintentionally delayed payment of the maintenance fee is a statement that the delay in payment of the maintenance fee was unintentional. The statement is only acceptable from a party responsible for payment of the maintenance fee.

In this instance, petitioner attempted to pay the maintenance fee based upon an unintentionally delayed payment, but failed to demonstrate that he was authorized to pay the maintenance fee on behalf of the party responsible for payment of the maintenance fee, the assignee.

The applicable rule, 37 CFR 1.378(d), states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest." (Emphasis supplied).

Petitioner repeatedly failed to demonstrate that he was authorized to act on behalf of the assignee. The applicable rule 37 CFR 3.73(b), provides:

- (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:
- (i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or
- (ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(Emphasis supplied).

Petitioner failed to provide either “documentary evidence of a chain of title from the original owner to the assignee,” or “a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).”

As to petitioner’s attempts to contact this Office via telephone, petitioner is directed to 37 CFR 1.2, which states:

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Regarding unavoidable delay, as noted supra, language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., “unavoidable” delay), and a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. The standard for revival of an abandoned application makes it clear that a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute “unavoidable” delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Moreover, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

It was petitioner's responsibility to either retain counsel or to familiarize himself with the laws, rules of practice and MPEP. The rules of practice do not diverge depending upon whether one is an attorney or an applicant appearing before this office in proper person. It is Applicant's obligation to inform himself about the obligations associated with prosecuting his application. See, California Med. Prods. V. Tecnol Med., 921 F.Supp 1219 (D. Del. 1995).

Conclusion

Patentee has failed to demonstrate that the failure to pay the maintenance fee was unavoidable.

The petition is dismissed.

Petitioner's current options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision. The petition for reconsideration should be entitled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of \$400 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to 'show' that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may file a (renewed) petition stating that the delay was unintentional¹.

¹ Under 35 U.S.C. 41(c)(1), the Director of the Office may accept late payment of any maintenance fee filed within 24 months after the 6-month grace period, if the delay in payment is shown to the satisfaction of the Director of the Office to have been unintentional. Here, the maintenance fee was filed within 24 months after the six month grace period had expired, and a renewed petition under 37 CFR 1.378(c) based upon an unintentionally delayed payment of the maintenance fee is available.

Petition to reinstate based upon an unintentionally delayed payment of the maintenance fee under 37 CFR 1.378(c)

Patentee is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in was “unavoidable.” An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the required fee.

The filing of a petition under 37 CFR 1.378(c) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to reinstate under 37 CFR 1.378(c), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition to reinstate the patent under 37 CFR 1.378(c).

37 CFR 1.378(c) states that “any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in § 1.362(e) and must include:

- (1) The required maintenance fee set forth in § 1.20 (e) through (g);
- (2) The surcharge set forth in § 1.20(i)(2); and
- (3) A statement that the delay in payment of the maintenance fee was unintentional.

III. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section, Commissioner for Patents, Washington, DC, 20231. A copy of this decision should accompany petitioner’s request.

Applicant is advised that, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Director for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

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